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EXAMINER	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOBY FREYMAN, TIMOTHY J. MICKLEY,
MARIA J. PALASIS, and WENDY NAIMARK

Appeal 2009-011016
Application 10/645,653
Technology Center 3700

Before WILLIAM F. PATE III, STEVEN D.A. McCARTHY and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 25-40 under 35 U.S.C. § 103(a) as being unpatentable over Clark (US 5,713,853, issued Feb. 3, 1998) and Ding (US 6,364,856 B1, issued Apr. 2, 2002). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 25 is the only independent claim on appeal. It is illustrative of the claims on appeal:

> 25. A medical device for delivering a therapeutic agent to an internal portion of a patient's body, the medical device comprising:
>
> a shaft;
>
> a self-expanding delivery member in operative communication with the shaft, the delivery member having a proximal end and a distal end and being shaped in a continuous solid cylindrical configuration from a porous material capable of (i) releasing the therapeutic agent to the internal portion of the patient's body and (ii) being in a collapsed state;
>
> a therapeutic agent delivery lumen defined by a lumen wall, wherein the therapeutic agent delivery lumen is in fluid communication with the delivery member for fluidly connecting the delivery member with a therapeutic agent source;
>
> a retention member in operative communication with the delivery member, the retention member being configured and arranged to selectively collapse the delivery member; and
>
> a mechanism capable of applying negative pressure through the therapeutic agent delivery lumen to remove fluid from the delivery member.

Independent claim 25 requires the use of a self-expanding delivery member being shaped in a continuous *solid* cylindrical configuration from a porous material. (App. Br. 10-12, Reply Br. 2-8). The Examiner incorrectly finds that "Ding et al. teach in Figures 2 and 3 that it is known to use a delivery member having a continuous solid cylindrical shape." (Ans. 3). The Examiner has not identified the structure in Ding's Figures 2 and 3 which is a solid.

The issue raised in this appeal may be resolved by interpreting the term "continuous solid" as used in the claims. In the absence of an express definition of a claim term in the specification or a clear disclaimer of scope, the claim term is interpreted as taking any ordinary and customary meaning recognized by one of ordinary skill in the art consistent with the overall disclosure of the specification. *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The Specification does not provide an explicit definition for the term "continuous solid" but does provide useful insight to deduce what a "continuous solid" is not. The Specification on paragraph [0027] on page 6 discusses the advantages of a solid cylindrical configuration including, "[t]he solid configuration gives the agent delivery member 18 greater structural strength, preventing *accidental tears* in the agent delivery member 18." (italics added).

Furthermore, the Background of the Invention section of the Specification in paragraph [005] on page 1 discusses the use on an *inflatable member*, .i.e., a balloon, which exerts significant pressure upon a lumen wall to force a therapeutic agent from a delivery member. As such the Appellants

appear to differentiate between an inflatable member, i.e., a balloon, and a continuous solid cylindrical configuration from a porous material capable of (i) releasing the therapeutic agent to the internal portion of the patient's body and (ii) being in a collapsed state. Although it is clear from Figure 6 of the Specification 6 that a balloon, i.e., balloon *170*, can be part of the overall medical device, a balloon cannot be considered a self-expanding delivery member shaped in a continuous solid cylindrical.

Therefore, the term "continuous solid" excludes a hollow balloon. The Appellants correctly contend "[t]he devices of both Clark et al. and Ding et al. are hollow, i.e., they have lumens extending through the delivery member." (Reply Br. 8). The Examiner articulates no reasoning which might explain why it would have been obvious from the combined teachings of Clark and Ding to provide a medical device including a self-expanding delivery member shaped in a continuous solid cylindrical configuration as recited in claim 25 despite the failure of either Clark or Ding to describe this feature. We do not sustain the rejections of claims 25-40 under § 103(a) as being unpatentable over Clark and Ding.

DECISION

We REVERSE the Examiner's decision rejecting claims 25-40.

REVERSED

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